REMARKS

Claims 1-17 are currently pending. Claim 1 has been amended, the amendment of which is supported by page 5, line 32, through page 6, line 3, of the specification as filed. Claims 3-6 have been amended for clarification purposes only. New claims 9-17 are supported by the original claims, page 4, lines 6-39, of the application as filed, and Figures 1, 3, and 4. It is respectfully submitted that no new matter has been added.

The Patent Office rejected claims 1-8 under 35 U.S.C. 112, second paragraph as being indefinite by alleging that "favourable case" is unclear in meaning.

In response, Applicant has amended claim 1 to recite "a favourable case in which the GERAN controlled cell is determined to support the UMTS service." It is respectfully submitted that no new matter has been added and respectfully requested that the Patent Office withdraw its rejection of claims 1-8 under 35 U.S.C. 112, second paragraph.

The Patent Office rejected claims 1-6 and 8 under 35 U.S.C. 103(a) as being unpatentable over Mildh, U.S. Published Patent Application No. 2002/0193139, in view of ETSI 3GPP 04.18 v 9.0.

Mildh discloses a method for selecting a mode of operation for a mobile station in a mixed telecommunication system comprising first and second core networks where first and second modes of operation correspond to the first and second core networks (abstract). Mildh seems to only contemplate that mode selection will occur through 3 bits in an existing SI or PSI message (e.g., paragraphs 0019-0031). Figure 2 of Mildh presents an example of the use of three bits to signal a mode of operation.

The Patent Office has asserted that Mildh does not disclose a method step defined in claim 1, wherein the spare bit of SI3 is used for indicating whether a cell supports an UMTS service or not. For this reason, the Patent Office has asserted that Section 9.1.35 of ETST Standard GSM 04.18 discloses claim 1 subject matter deficient in Mildh. Also, the Patent Office focuses on 'Cell Options' and 'Cell Selection,' whereas the spare bit is located in the Rest Octets. Applicant notes that Section 9.1.35 does not provide the teaching that the Patent Office alleges and further notes that the claimed subject matter does not appear in Section 9.1.35.

In addition, Mildh seems not to disclose an operation, wherein, in the case the current GERAN cell supports UMTS service through the Iu interface, a message is sent including a

description of the channel where Iu information for mobile stations is placed.

Thus, claims 1-8 are allowable over Mildh in view of ETSI Standard GSM 04.18.

Furthermore, Applicant's current application has a foreign priority date of January 10, 2002, through Swedish patent document number 20020048. The foreign priority date is prior to the filing date of March 12 2002 of Mildh. Even though Mildh claims priority to U.S. provisional patent application no. 60/280,305, it is not known if the subject matter upon which the Patent Office relies in rejecting the current claims is also found in this provisional patent application.

The Patent Office rejected claim 7 under 35 U.S.C. 103(a) as being unpatentable over Mildh, U.S. Published Patent Application No. 2002/0193139, in view of ETSI 3GPP 04.18 v 9.0 as applied to claim 3 above, and further in view of Raith, U.S. Patent No. 5,930,706.

The Patent Office has asserted that a deficiency of both Mildh and ETSI 3GPP 04.18 v 9.0 is that neither expressly discloses "said Iu to transfer the second message." The Patent Office asserted that Raith, in column 21, lines 22-57, discloses using the Iu to transfer the second message. Raith, on the contrary, teaches that the fast BCCH (F-BCCH) is used to transmit "information defining the system configuration and the rules for system access by mobile stations" (column 21, lines 25-27) and that the extended BCCH (E-BCCH) is used to transmit overhead information at a lower rate (column 21, lines 30-32) and that changes in F-BCCH and E-BCCH are indicated by their respective change flags (column 21, lines 45-50). There is no disclosure by Raith for claim 7's subject matter of the "Iu indicator field indicates, whether normal BCCH or extended BCCH is used to transfer the second message."

Thus, claim 7 is allowable over the prior art of record because Raith does not teach claim 7's subject matter and, additionally, because none of Mildh, ETSI 3GPP 04.18 v 9.0, and Raith teach the spare bit of SI3 is used for indicating whether a cell supports an UMTS service or not.

It is respectfully submitted that the rejections of claims 1-8 under 35 U.S.C. 103(a) based on Mildh, in view of ETSI 3GPP 04.18 v 9.0, whether or not further in view of Raith, have been overcome, and respectfully requested that the Patent Office reconsider and remove the rejections of these claims. The Patent Office is respectfully requested to favorably consider and allow all of the pending claims 1-17 as now presented for examination. An early notification of the

allowability of claims 1-17 is earnestly solicited.

Respectfully submitted:

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Nov. 30, 2007 J. Dworicak

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